

REMARKS/ARGUMENTS

Claims 1 and 4-17 were pending in the application.

New claims 18-35 have been added.

In the Claims:

Allowable Subject Matter In Claims 9, 12, and 14

The Examiner has indicated that claims 9, 12, and 14 would be allowable if rewritten in independent form including all limitations of the base and intervening claims.

Although Applicants disagree with the grounds for rejection of those base and intervening claims, they have adopted the Examiner's suggestion and claims 9, 12, and 14 have each been amended to independent form by the incorporation of the limitations of:

claims 1, 5, and 6, for amended claims 9 and 12; and

claims 1, 5, and 13, for amended claim 14.

Thus, the Applicants submit that amended independent claims 9, 12, and 14 are in condition for allowance.

Independent Claim 1 and Its Dependent Claims vs. US 4,588,910 to Bausch

Independent Claim 1 and remaining dependent claims 4-8, 10, 11, 13, 15 and 17 stand rejected as either anticipated by or unpatentable over Bausch '910 alone or, in the case of claim 11, in view of US 5,738,177 to Schell. Therefore, to better distinguish the current invention, Claim 1 is amended herein to require a handle projecting from a first side of the housing, that the first manually operable switch member (4) is located in the handle and adjacent to the integrated switch unit, and the second manually operable switch member (14) is located in the housing at a second side substantially opposite to the first side. In contrast, the Bausch '910 trigger switch 2, the integrated switch unit 35/36, and the reversing switch 9/10 are all located together in the handle. Nor, does Bausch '910 disclose a linkage for operatively connecting a motor control unit located (adjacent to a power switch) on a first side of the housing with a reversing

switch located on an opposite side of the housing. Therefore, Applicants submit that amended independent claim 1 and its associated dependent claims are distinguished from Bausch '910 and are allowable.

Independent Claim 17 vs. the Combination of Bausch '910 and Dibbern '774

Independent claim 17 stands rejected under 35 U.S.C. §103(a) as unpatentable over Bausch '910 in view of US 4,684,774 to Dibbern. Regretfully, Applicants must again argue that neither Bausch '910 alone nor in combination with Dibbern '774 teaches, motivates, or suggests the claimed combination of elements.

Firstly, regarding the Examiner's proposed combination of Bausch '910 and Dibbern '744, the Applicants respectfully note that neither reference supplies the Claim 17 "linkage arrangement" which is required to "operatively connecting the second manually operable switch member to the motor control unit" when the motor control unit is located in the handle and the second manually operable handle is "projecting through the upward facing portion of the motor housing." Dibbern '744 does have a reversing switch 79 located atop the tool and opposite to handle mounted trigger 14, but the linkage 64 is operative connected to trigger 14 (only for preventing change of motor direction when power is ON) and not to an integrated switch unit and associated motor control unit. Dibbern '744 col. 9 lines 20-34.

Secondly, the grounds for rejection need to specifically identify the teaching and/or motivation that would lead one of ordinary skill in the art to select the references and combine them in the way proposed. *See In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). *See also* MPEP §2143.01. Both the motive and expectation of success must be found in the prior art and not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ 1438 (Fed. Cir. 1991). In the subject case, the references cited by the Examiner do not teach or motivate the combination.

Bausch '910 does not criticize its own arrangement and, even if there were motive to relocate the reversing switch in Bausch to the top of the tool, there is no teaching or

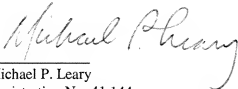
suggestion about how to achieve it. Dibbern '774, on the other hand, does not teach an integrated switch unit, therefore Dibbern does not suggest a need to operatively connect its top mounted reversing switch 79 with a remote motor control unit located in the handle. Furthermore, in Dibbern '774 the reversing assembly 62 is itself a large switch that changes the direction of rotation of the motor by acting directly on the electrical interconnections between motor contact elements 45, 46, 63, 70, and would not require the proposed linkage to a motor control unit. Dibbern '774 at col. 9 lines 2-12. Therefore, Dibbern '774 would appear to teach away from the proposed combination, since it articulates numerous advantages in motor installation and control for its disclosed structure, which advantages would be lost if the separate and distinct reversing mechanism described therein were replaced by the integral switch unit in Bausch '910.

The requirement of identifying motive and/or suggestion to combine two references, even if they are analogous art, is set very high. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (while reversing a 35 U.S.C. §103 rejection, the court found no suggestive or incentive to combine two prior art landscaping and grading references to produce the applicant's simple lawn edging invention). The Applicants do not find this motive or suggestion in either of the cited references. Indeed, Dibbern's overall structure and listed advantages teach away from the proposed combination. The Examiner has ignored the Applicants' earlier requests to identify the source of motive or suggestion for the proposed combination. Simply stating that it would be "obvious" does not answer the question or satisfy the requirement. Therefore, Applicants again respectfully request the Examiner to identify the source of the motive or suggestion to modify Bausch '910 in view of Dibbern '774, or to withdraw the rejection.

For the reasons given above, Applicants respectfully submit that independent claims 1 and 17 are novel and allowable over the prior art of record. Since the Applicants believe they have demonstrated the novelty of independent claims 1 and 17, it is not necessary to separately address the rejections of the associated dependent claims (nor of the new claims 18-26 dependant from claim 17) and the various reasons given for those rejections.

New claims 18-35 (including new independent claim 27) are submitted for consideration.

Respectfully submitted



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